



UNITED STATES PATENT AND TRADEMARK OFFICE

*mk*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,673	08/19/1999	MASAYUKI YAMANA	20-4594P	6781

7590 12/12/2001

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
----------	--------------

1713

*13*

DATE MAILED: 12/12/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/355,673

Applicant(s)

YAMANA ET AL

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-8, 12 and 14-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 2-8 and 14-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

- ✓ 1) The disclosure is objected to because of the following informalities: The "Table 3", at least, per the specification is inconsistent with the dictionary definition which is an orderly arrangement of data arranged in columns and rows.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 6, 19, 20, 22, 23, 27, 28, 33 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- A) The recited "a monomer having conjugated double bonds or one or two carbon to carbon double bonds" per claim 6 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited optional repeating units (III).
- B) The recited "in said container outside" per claims 19, 20, 22 and 27 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact meaning of the term "outside", in this context, i.e., does applicant intend "the outside of the container" or "outdoors".
- C) The recited "using water" per claims 23, 28 and 33 constitutes indefinite subject matter as per it not being readily ascertainable as to the intended meaning of this

phrase, i.e., does applicant intend adding water to the composition before application to a substrate or else.

D) The recited "A<sup>2</sup> is -- a hydrophilic group or a group having a hydrophilic group" per claim 35 constitutes indefinite subject matter as per it is not readily ascertainable as to how "a hydrophilic group" differentiates over "a group having a hydrophilic group".

***Response to Amendment***

3) Applicant's response and request for reconsideration and withdrawal of the rejection based on Ito et al per paper no. 12, 09/28/01 has been fully considered and found persuasive. However, after an extensive review of the file, new prior art was discovered and a rejection based on such is deemed proper and is as set forth infra.

Applicant's arguments relative to the Objection to the specification has been considered but not found persuasive as per reasons clearly set forth supra.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims <sup>2</sup>~~1~~-8, 12 and 14-33 are rejected under 35 U.S.C. 102( b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 272,988(Katsuji et al) or Misaizu et al(U.S. 5,068,295).

Katsuji et al teach water and oil repellant compositions defined as containing a copolymer containing a) a polymerizable compound containing a perfluoroalkyl group and b) a (meth)acrylate having a urethane bond wherein said copolymer is formed via emulsion polymerization using a ketone solvent. See the Abstract, page 4, Run 1 and the claims of Katsuji et al.

Misaizu et al teach a water and oil repellent composition containing a copolymer of a vinyl monomer having a perfluoroalkyl group, a vinyl monomer having a polyorganosiloxane chain, a vinyl monomer having an isocyanate group and other copolymerizable vinyl monomers. See the Abstract, cols. 2-6, 8-15(examples inclusive) and the claims of Misaizu et al.

Each of patentees therefore anticipate the instantly claimed invention with the understanding that the copolymers of patentees overlap in scope with the claimed copolymers.

6) Claims 34 and 35 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 15,695(Yoshio et al) or JP 214,197(Yasuyuki et al).

Each of Yoshio et al and Yasuyuki et al teach copolymers derived from a perfluoroalkyl group-containing monomer and other copolymerizable vinyl monomers. See the Abstract, pages 4-5 and the claims of Yoshio et al and the Abstract, pages 3-5

and the claims of Yasuyuki et al. Each of Yoshio et al and Yasuyuki et al therefore anticipate the instantly claimed invention with the understanding that the copolymers of patentees overlap in scope with the claimed copolymers.

***Response to Arguments***

8) Applicant's arguments with respect to claims 1-8, 12 and 14-35, now 2-8, 12 and 14-35, have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9) Counsel's request for an interview in order to expedite prosecution is herein acknowledged. However, an interview at this stage would be futile since counsel has not had the opportunity to review the new rejections set forth supra. Moreover, the Examiner should be apprised of an interview request prior to the due date of the application.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703) 308-4346. The examiner can normally be reached on Monday-Friday, 6:30 A.M.-3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wu David can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2381.

Application/Control Number:  
09/355,673  
Art Unit: 1713

Page 6

JMR *JMR*  
December 8, 2001

*J. M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713